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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,789	04/14/2004	Robin L. Heilman	63288-654	4683

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EXAMINER

DESAI, HEMANT

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,789

Applicant(s)

HEILMAN, ROBIN L.

Examiner

Hemant M Desai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/14/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Several phrases in the claims are vague, misleading and or indefinite, for example: "between the upper drive portion and lower drive portion," (claims 1 and 31, line 10; claim 2, line 5; claim 8, lines 7-8) it not understood how the plurality of gripping members can pass between the upper drive portion and lower drive portion, since the path created between the upper drive portion and lower drive portion is such that only envelopes can pass between the upper drive portion and lower drive portion, "the envelope stuffing device registration member." (claim 32, line 12) is confusing because it not understood what exactly applicant is referring to, "a plurality.....drive member" (claims 1 and 31, line 8; claim 2, line 3) it is not clear whether the gripping members are located on the drive member (chain) or they are located parallel to or besides the drive member. Further, the phrase "the envelope stuffing device registration member" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Webber (4913415).

Webber discloses a transport machine comprising a drive system comprising an upper drive portion (upper belts 27, fig. 2) and a lower drive portion (lower belts 22, fig. 2), each of the upper drive portion and the lower drive portion comprising a plurality of laterally spaced apart belts (27, 22) disposed about a plurality of pulley elements (23, 26, fig. 2) and at least one driving member (guide roller 29, 25, fig. 2) to move the plurality of belts of the upper drive portion (27) and lower drive portion (22) at a first speed, an transmission device (belt 10, fig. 2) disposed to input envelopes into the slip-drive between the plurality of belts of the upper drive portion (27) and lower drive portion (22), a plurality of gripping members disposed at intervals along a first drive member (54, fig. 3) comprising a belt, disposed to pass between the plurality of laterally spaced apart belts (27 and 22), the first drive member being driven at a second speed lower than the first speed (belt 15 is driven at slower speed, see col. 3, lines 59-68) and upon registration of an envelope (sheet 7, fig. 3) within the gripping member (belts 15 can be presses against the sheet 7, see col. 6, lines 18-21), the gripping member closes to retain the envelope. "wherein envelopes input into the slip-drive are moved at a speed greater than a speed of the gripping members so that an envelope borne by the slip-drive overtakes a corresponding one of the plurality of gripping members and is

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registered therein" is a functional language and does not recite sufficient structure of the machine.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webber in view of Cohen (5414977).

The transport machine of Webber, as mentioned above, discloses all the claimed limitations, except for an envelope-stuffing device.

However, Cohen teaches an envelope-stuffing device (10, fig. 1) so that a number of inserts can be placed into a single envelope and after stuffing the inserts into the envelope is complete, the stuffed envelope is carried away (see col. 1, lines 65-68). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the envelope stuffing device as taught by Cohen in the transport machine of Webber so that a number of inserts (sheets) can be placed into a single envelope and after stuffing of the inserts into the envelope is complete, the stuffed envelope is carried away.

Allowable Subject Matter

7. Claims 31-32 are would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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8. Claims 2-3, 8-13, 28-29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 5-7, 14-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 7:00 AM-5: 30 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant M. Desai.